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|---------------------------------|-------------|-----------------------|---------------------|------------------|
| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/073,608                      | 02/11/2002  | Vadakkedathu T. Rajan | YOR920020050        | 5945             |
| 7590                            | 11/26/2008  |                       | EXAMINER            |                  |
| IBM CORPORATION                 |             |                       | BROWN JR, NATHAN H  |                  |
| INTELLECTUAL PROPERTY LAW DEPT. |             |                       |                     |                  |
| P.O. BOX 218                    |             |                       | ART UNIT            | PAPER NUMBER     |
| YORKTOWN HEIGHTS, NY 10598      |             |                       | 2129                |                  |
|                                 |             |                       | MAIL DATE           | DELIVERY MODE    |
|                                 |             |                       | 11/26/2008          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                       |                                     |
|------------------------------|---------------------------------------|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/073,608  | <b>Applicant(s)</b><br>RAJAN ET AL. |
|                              | <b>Examiner</b><br>NATHAN H. BROWN JR | <b>Art Unit</b><br>2129             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 October 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 6-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

Examiner's Detailed Office Action

1. This Office Action is responsive to the communication for application 10/073,608, filed October 2, 2008.
2. Claims 6-10 are pending. Claims 6, 7, 11, 12, 16 are currently amended. Claims 8-10, 13-15 are previously presented. Claims 17 and 18 are new.
3. After the previous office action, claims 6-15 stood rejected.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention has no practical application. Amended independent claim 6 recites a "computer readable storage medium

Art Unit: 2129

including computer instructions executable on a computer for carrying out a method of characterizing objects generated during at least a partial run of a program" which produce no final result.

The final step (f) of the computer executable instructions is to "implement said allocation strategy to select among the alternative properties for an object subsequently created during an at least partial run of said program based upon characterization information about the subsequently created object". Examiner considers implementing an "allocation strategy to select among...alternative properties" to be merely a continuation of processing. Clearly, therefore, claim 6 recites no tangible real-world result (such as the *final share price* momentarily *fixed* for recording and reporting as in *State Street*). Therefore, claim 6 is considered to have no practical application and to be non-statutory under 35 U.S.C. 101. Claims 7-10 provide further data and algorithmic limitation to claim 6 but fail to cure the deficiency of claim 6. Therefore, claims 6-10 are considered to be non-statutory under 35 U.S.C. 101.

However, the portions of the opinions in *State Street* and AT&T relying solely on a "useful, concrete and tangible" result analysis *should no longer be relied on*. *Ex parte Bilski*, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

The court has said that there's a two-pronged test to determine whether a software or business method process patent is valid: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. In other words, pure software or business method patents that are neither tied to a specific machine nor change something into a different state are not patentable. *Ex parte Bilski*, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

6. Claims 11-18 are rejected under 35 U.S.C. 101 for the same reason as claims 6-10.

#### Response to Arguments

7. Applicants' arguments filed October 2, 2008 have been fully considered.

#### Rejection of Claims 6-15 Under 35 U.S.C. §101

Applicant(s) argue(s):

The Office Action rejected claims 6-15 under 35 USC 101 as being directed to non- statutory subject matter.

...

Claim 6, as amended, and its dependent claims all relate to a tangible object - a computer readable storage medium. Support for the amendment is found at paragraph [0046] of Patent Application Publication No. 2002/0165901. Therefore, those claims relate to patent eligible subject

matter.

Claim 11 has been amended to specify that the method is carried out in a computer system. The Federal Circuit recently held that:

"a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. 35 U.S.C. § 101.

See *In re Comiskey*, 499 F.3d 1365, 1377 (Fed. Cir. 2007). In the instant case, method claim 11 involves the statutory class of machines. Therefore, claim 11 and its dependent claims recite patentable subject matter.

Examiner responds:

Examiner finds Applicants' argument persuasive; however, claims 6-18 remain rejected under 35 USC 101 due to Applicants' amendments. Applicants amended claims 6 and 11 to recite statutory subject matter, however failed to provide tangible real-world final results.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action

Art Unit: 2129

is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan H. Brown, Jr. whose telephone number is 571-272- 8632. The examiner can normally be reached on M-F 0830-1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on 571-272-3080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2129

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nathan H. Brown, Jr./  
Examiner, Art Unit 2129  
November 26, 2008

/David R Vincent/

Supervisory Patent Examiner, Art Unit 2129